

REMARKS

Claims 10, 11 and 13 are presently pending. The following addresses the substance of the Office Action.

Anticipation

Claims 10, 11 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Feldman et al. (U.S. Patent No. 6,299,757). Specifically, the Examiner stated that Feldman discloses the biosensor of the present invention and the capillary action at column 32, lines 7-13. The Examiner also asserted that Feldman discloses a projection and an inside corner part in Figs. 18B and 22B. However, the structure of the biosensor of the invention as claimed is very different from that of Feldman.

One of the main features of the biosensor of the claimed invention is “a projection at only one side of the spacer sheet end in the holding space with the projection extending toward the end of the biosensor.” This feature is discussed in detail in the Specification as filed on page 27, line 1 to page 30, line 13. In contrast, Feldman et al. discloses a sensor that has two projections, one on each side. Referring to Figure 18B of Feldman, the sensor depicted has a spacer sheet with entrance 514 at the end portion and projections on both sides of the entrance. Similarly, Figure 22B shows entrance 582 at the end portion with projections provided on both sides of the entrance. Specifically, the two projections consist of the projection pointed out by the Examiner, and also projection 587. In this respect, the teachings of Feldman are completely different from that of the present invention, i.e., “a biosensor provided with a projection at only one side of the spacer sheet.”

Moreover, Feldman et al. discloses at column 32:7-13 that “a non-conductive material, such as a non-conductive ink, can be formed adjacent the working electrode to provide a planar surface along the path of travel of the liquid sample. The non-conductive material is suitable for creating a smooth surface to facilitate filling by capillary action.” In other words, Feldman merely discloses that the capillary action is performed by the smooth surface formed of the non-conductive material. Therefore, even if Feldman discloses capillary action, the capillary action disclosed in that reference has nothing to do with the feature of the present invention, i.e., providing the projection extending toward the end of the biosensor at only one side of the spacer sheet end.

The Examiner asserts that Feldman discloses an inside corner part provided in the inner part of only one side of the channel (from which the liquid sample is introduced). The Examiner used an arrow to point out the presence of an inside corner part in Fig. 18B. However, this is not an inside corner part, but merely a bend in the flow stream that allows the liquid sample from the entrance 504 to pass to the channel 506 provided on the side of the spacer sheet. Thus, the structure of Feldman is the same as that of a conventional biosensor (e.g., unexamined Japanese Patent Publications 2001-311712 and 2001-356108, as listed in the International Search Report). Specifically, projections are provided on both sides of the end portion of the sensor. Therefore, such a structure is fundamentally different from that of the present invention. Accordingly, there must be another inside corner part in the inner part of the channel, in addition to that pointed out by the Examiner. It is clear that bubbles cannot be discharged by such a structure.

To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed.Cir. 1986). “[A]nticipation requires that all of the elements and limitations of the claim are found within a single prior art reference.” See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). In the present case, the claimed biosensor has a single projection at only one side of the spacer sheet end in the holding space. In contrast, the sensor of Feldman has projections on both sides of the end portion of the sensor. Moreover, as discussed above, the biosensor of Feldman does not comprise an inside corner part. Instead, it merely has a bend in the flow stream that allows the liquid sample from the entrance to pass to the channel provided on the side of the spacer sheet. Thus, the claimed structure is physically novel over that disclosed by Feldman.

Moreover, the presently claimed biosensor is functionally novel over the prior art as well. By having a single projection at only one side of the spacer sheet end in the holding space, a liquid sample can be smoothly introduced without leaving bubbles in the holding space. This advantageous feature is not disclosed by Feldman. According to the structure shown in Fig. 18B of Feldman et al., the liquid sample entering through entrance 514 is discharged from the channel 506; i.e., there is no holding space (S) at its end. In the present invention, the projection provided at only one side of the spacer sheet end reduces the remaining bubbles in the holding space. Thus, the present invention differs from the disclosure of Feldman in this respect, as well. One having ordinary skill in the art would not have any reason to modify Feldman to incorporate

the physical differences from the claimed invention and expect these excellent functional results. Accordingly, the subject matter of Claim 10 and dependent Claims 11 and 13 is patentable over Feldman. Accordingly, the Applicants respectfully request removal of the rejection under 35 U.S.C. § 102(b), and allowance of the claims.

No Disclaimers or Disavowals

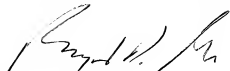
Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 21, 2009

By: 
Raymond D. Smith
Registration No. 55,634
Agent of Record
Customer No. 20995
(949) 760-0404